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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,002	10/16/2000	Scott C. Harris	SPAM/SCH	2977
23844	7590	02/09/2006	EXAMINER	
SCOTT C HARRIS P O BOX 927649 SAN DIEGO, CA 92192			DENNISON, JERRY B	
			ART UNIT	PAPER NUMBER
			2143	
DATE MAILED: 02/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,002

Applicant(s)

HARRIS, SCOTT C.

Examiner

J. Bret Dennison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 14-16, 21, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14-16, 21, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in response to Amendment for Application Number 09/690,002 received on 11/01/2005.
2. Claims 1-7, 14-16, 21, and 23-24 are presented for examination.
3. The prosecution for this case has been transferred to another Examiner.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, 14-16, 23, 24, drawn to displaying of controls that allow the deletion of email messages, classified in class 709, subclass 203.
 - II. Claim 21, drawn to determining if an email message is spam by comparing with a list of characteristics, classified in 709, subclass 206.
5. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility for deleting email, which is separately usable with or without invention II, which provides determining if an email message is considered to be spam by comparing to a list of characteristics. See MPEP § 806.05(d).

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6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Scott Harris (Reg. No. 32,030) on 1/30/2006, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-7, 14-16, 21, and 23-24. Affirmation of this election must be made by applicant in replying to this Office action. Claim 21 is withdrawn from further consideration by the Examiner, (See 37 CFR 1.142(b)), as being drawn to a non-elected invention.

112, now that claim 1 includes all 3 functionalities, claim 2 is unclear since it does not distinguish at what time the database is updated, whether it is "while indicating that it is spam" or "indicating that it is not spam".

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As stated in the previous rejection, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of

the programs, are not physical "things". They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

9. Claims 14-16 include an "email program comprising: a display... and a plurality of controls..." Such limitations are simply features of the program. In other words, the program includes code to display the emails; the program includes code that provides users to control deleting emails. There is no physical structure defined or any functional interrelationships between the email program and any actual physical elements of a computer. Therefore there is no way for a user to interact with the program, since it is not tangibly embodied and executed on a computer readable medium. Examiner maintains the 35 U.S.C. 101 rejection for claims 14-16.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Pang (U.S. 6,493,007).

10. Regarding claim 14, Pang disclosed an e-mail program having instructions embodying on a computer readable media that are executable by a computer, comprising:

a display portion which is display a plurality of e-mails (Figure 4),

a plurality of controls including at least a first control which selects deleting an e-mail while indicating that said e-mail is spam, and a second control which selects deleting an e-mail while indicating that said e-mail is not spam (Figures 4, 5, column 8 line 63-column 9 line 13, column 10 lines, lines 30-36, Pang disclosed the user being able to delete "desired" email, as well as delete "SPAM" email).

Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Horvitz et al. (U.S. 6,161,130).

11. Regarding claim 14, Horvitz disclosed an e-mail program having instructions embodying on a computer readable media that are executable by a computer, comprising:

a display portion which is display a plurality of e-mails (Horvitz, Fig. 2, 120),
a plurality of controls including at least a first control which selects deleting an e-mail while indicating that said e-mail is spam, and a second control which selects deleting an e-mail while indicating that said e-mail is not spam (Horvitz, Fig. 2, 223, 227).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 14, 23, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Pang (U.S. 6,493,007).

12. Regarding claims 1, 14, and 23, AAPA discloses the existence of web email programs in which electronic mail messages are received (AAPA, page 1, Background, lines 7-16). AAPA also discloses a conventional "delete message" button used to delete email messages without indicating whether it is spam or not (AAPA, page 4, line 15 through page 16, line 5, FIG. 1, 107).

AAPA also discloses that email may be filtered for spam (AAPA, page 1, Background, lines 15-20, AAPA discloses that junk email from a specified sender may be blocked, automatically deleted or sent to the trash).

AAPA does not explicitly state displaying information about the electronic mail message in a way that allows deleting a message while indicating that it is spam, and deleting the message while indicating that it is not spam.

In an analogous art, Pang disclosed a method and device for removing junk email that displays an icon that when actuated, removes indicated unsolicited email (Pang, col. 3, lines 50-55) as well as allowing users to delete desired e-mail messages (Pang, col. 9, lines 5-6).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of providing the ability to remove emails whether they are spam or desired for the benefit of allowing users to manage their mailbox without the automatic deletion, possibly leading to filtering out legitimate bulk email messages that are of interest to the user (Pang, col. 2, line 64 through col. 3, line 5).

13. Regarding claims 2-3, and 24, AAPA and Pang disclosed the limitations, substantially as claimed, as described in claim 1, including storing a database of spam likelihood, and wherein said deleting while indicating updates information in the database (Pang, co. 6 lines 27-39) and while indicating update rules in a rules database (Pang, col. 6 lines 27-39).

14. Regarding claims 4-5, AAPA and Pang disclosed the limitations, substantially as claimed, as described in claim 3, including wherein said rules include information about fields from said electronic mail message (Pang, col. 6 lines 27-39) and wherein said fields include at least a sender of the e-mail message, text, of the e-mail message, and a subject of the e-mail message (Pang, col. 6 lines 27-39),

15. Regarding claim 6, AAPA and Pang disclosed the limitations, substantially as claimed, as described in claim 5, including wherein said fields also include a domain of a sender of the e-mail message (Pang, col. 6 lines 27-39).

16. Regarding claim 7, AAPA and Pang disclosed the limitations, substantially as claimed, as described in claim 3. AAPA and Pang did not explicitly state that an email includes links. Examiner takes Official Notice (see MPEP § 2144.03) that email messages containing links in an email program environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ

231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or reputation of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

See the following references for the use of links within email addresses:

- a) Bergh et al. (U.S. 2002/0026356), paragraph 75
- b) Huang et al. (U.S. 2003/0097361), paragraph 79
- c) Shaak et al. (U.S. 2002/0198784), paragraph 50

Claims 1-7, 14, 23, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Horvitz et al. (U.S. 6,161,130).

17. Regarding claims 1, 14, 16, and 23, AAPA discloses the existence of web email programs in which electronic mail messages are received (AAPA, page 1, Background, lines 7-16). AAPA also discloses a conventional "delete message" button used to delete email messages without indicating whether it is spam or not (AAPA, page 4, line 15 through page 16, line 5, FIG. 1, 107).

AAPA also discloses that email may be filtered for spam (AAPA, page 1, Background, lines 15-20, AAPA discloses that junk email from a specified sender may be blocked, automatically deleted or sent to the trash).

AAPA does not explicitly state displaying information about the electronic mail message in a way that allows deleting a message while indicating that it is spam, and deleting the message while indicating that it is not spam.

In an analogous art, Horvitz disclosed a technique which can be utilized in substantially any email or electronic messaging application to detect messages which a given user is likely to consider “junk”, in which the technique utilizes a probabilistic classifier to detect “junk” email, and provide separate folders for **legitimate** mail (Horvitz, Fig. 2, 223) and **spam** email (Horvitz, Fig. 2, 227). Horvitz also allows users to update rules that the classifier follows in order to automatically determine the type of email, the updating of rules being based on how users manage their email (Horvitz, col. 5, lines 52-65).

The teachings of Horvitz also allows messages to be classified into categories including “certain-spam” (as in definitely spam), “questionable spam”, and “non-spam”. Therefore, Horvitz includes the concept of being able to **indicate** what type of email a message is, whether it is definitely spam, not sure if it is spam or not, and definitely not spam.

Since the technique of Horvitz works with standard email programs, it would have been obvious to one of ordinary skill that the technique of Horvitz includes the ability to delete email from each folder, as standard email programs include a “delete” button to

delete emails. Therefore, when a user deletes a message from the "legitimate" folder, the message is being deleted with an indication that it is not spam. When a user deletes a message from the "spam" folder the message is being deleted with an indication that it is spam. When the user deletes a message from the inbox of the standard email program, the message is being deleted without an indication that it is spam or not.

Since the technique of Horvitz can be utilized in any other email applications, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the technique of Horvitz into conventional email programs as specified by AAPA for the benefit of allowing the users to individually filter their incoming messages, by their content, as they saw fit based on user preferences of the content (Horvitz, col. 4, lines 31-37).

18. Regarding claims 2-3, 24, AAPA and Horvitz disclosed the limitations, substantially as claimed, as described in claim 1, including storing a database of spam likelihood, and wherein said deleting while indicating updates information in the database and while indicating update rules in a rules database (Horvitz, col. 5, lines 50-65, col. 8, lines 55-67).

19. Regarding claims 4-5, AAPA and Horvitz disclosed the limitations, substantially as claimed, as described in claim 3, including wherein said rules include information about fields from said electronic mail message and wherein said fields include at least a

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sender of the e-mail message, text, of the e-mail message, and a subject of the e-mail message (Horvitz, col. 9, lines 15-50, col. 10, lines 10-25),

20. Regarding claim 6, AAPA and Horvitz disclosed the limitations, substantially as claimed, as described in claim 5, including wherein said fields also include a domain of a sender of the e-mail message (Horvitz, col. 9, lines 25-35).

21. Regarding claim 7, AAPA and Horvitz disclosed the limitations, substantially as claimed, as described in claim 3. AAPA and Horvitz did not explicitly state that an email includes links. Examiner takes Official Notice (see MPEP § 2144.03) that email messages containing links in an email program environment was well known in the art at the time the invention was made. See the previous Official Notice Rejection of claim 7 for further detail.

22. Regarding claim 15, AAPA and Horvitz disclosed the limitations, substantially as claimed, as described in claim 14. AAPA and Horvitz also disclosed allowing the user to be able to visually distinguish the message based on the color of the message, the color of the message deemed to be a certain degree of spam (Horvitz, col. 5, lines 20-30). AAPA and Horvitz did not explicitly state displaying a likelihood of spam coefficient which indicates, on a weighted scale, a likelihood that the associated message represents spam. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display a coefficient rather than distinguish by

color since both functionalities produce the same outcome, which benefits users by providing them a way to determine to what degree the message is considered spam.

23. The prior rejections for claims 14-16 are respectfully maintained, because the amendment filed 11/01/2005 does not sufficiently alter breadth of the claims to obviate over the applied references. The rejections issued in the Office Action mailed 6/01/2005 remains applicable for rejecting the claims, and is therefore incorporated by reference.

Response to Arguments

Applicant's arguments filed 11/01/2005 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-7, 23, and 24 have been considered but are moot in view of the new ground(s) of rejection. Claims 14-16 are the only claims that have not been amended. The previous rejections for these claims are maintained.

Applicant's arguments with respect to **claims 14-16** are as follows:

Applicant argues, "Nowhere does Pang in any way teach or suggest the two claimed controls – one which enables deleting while indicating that the e-mail is spam, and the other which deletes the e-mail while indicating that it said e-mail is not spam" [see Applicant's response, page 7, last paragraph].

Examiner respectfully disagrees. Pang disclosed a “NO SPAM!” button (Pang, Fig. 5, 521) that indicates that it **is spam** and it is removed when clicked. Pang also disclosed a “delete” button (Pang, Fig. 5, 519) that when clicked, the indication that it is **not spam** is inherent, because if it were spam, the “NO SPAM!” button would have been clicked. Therefore Pang disclosed both functions.

Applicant argues, “Claim 14 allows the system to learn from either known junk mails or known non-junk mails. Neilsen has no disclosure of such” [See Applicant’s response, page 11, first paragraph]. Applicant also argues that Neilsen does not meet deleting “the e-mail while indicating that said e-mail is not spam. This allows learning characteristics of e-mails which are NOT spam”. [See Applicant’s response, page 11, third paragraph].

Examiner respectfully disagrees.

Neilsen disclosed a “Delete as Junk Mail” button (Neilsen, Fig. 4b, 425) that indicates that it **is spam** and it is removed when clicked. Neilsen also disclosed a “delete message” button (Neilsen, Fig. 4b, 427) that when clicked, the indication that it is **not spam** is inherent, because if it were spam, the “Delete as Junk Mail” button would have been clicked. Therefore Neilsen disclosed both functions.

Regarding the argument that “this allows learning characteristics of e-mails which are NOT spam”, the claims do not recite this limitation or any use of the indications whatsoever. Regarding claim 16, Applicant argues that Nielsen did not disclose a third option. Examiner respectfully disagrees. Claim 16 reads, “further comprising displaying

a control which allows deleting an e-mail without indicating or not indicating whether said e-mail represents spam.” The claim simply requires a control that deletes an email, as disclosed by Neilsen (Neilsen, Fig. 4b, 427).

It is the Examiner’s position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant’s disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner’s Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

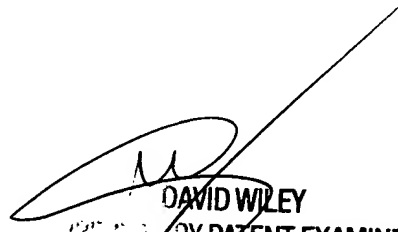
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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J. B. D.
Patent Examiner
Art Unit 2143



DAVID WILEY
PATENT EXAMINER
EBC CENTER 2100